

Remarks/Arguments

This Amendment is being filed in conjunction with a Request for Continued Examination in accordance with 37 C.F.R. § 1.114. Applicants request entry of this Amendment under 37 C.F.R. § 1.116 in lieu of the Supplemental Amendment filed September 15, 2009, which was not entered as indicated on page 2 of the current Office Action.

Claims 1, 2, 5, 8, 9, 12 and 13 were pending in the application. With this Amendment, claims 1 and 12 are amended and new claims 14 and 15 are added. Accordingly, claims 1, 2, 5, 8, 9, and 12-15, with claims 12 and 13 withdrawn as being directed to a nonelected invention, are pending in the application.

Interview Summary

As a preliminary matter, Applicants thank Examiner Cordray for speaking with Applicants' attorney on November 19, 2009 in a telephonic Examiner Interview. Applicants also thank Examiner Cordray and his supervisor, Examiner Steven Griffin, for speaking with Applicants attorneys in subsequent follow-up telephone calls. As indicated in the Examiner Interview Summary dated November 27, 2009, the subject of the Examiner Interview was the rationale behind the Office's decision, which was discretionary according to M.P.E.P. § 706.07(a), not to enter Applicants' Supplemental Amendment filed on September 15, 2009. Specifically discussed were the reasons why the Office did not enter the Supplemental Amendment, which was intended by Applicants to advance prosecution, and consider the claims therein in its Final Rejection dated September 29, 2009. Applicants noted that the Final Rejection was issued after the Supplemental Amendment was filed. The Final Rejection was based on the reference submitted in the Information Disclosure Statement filed on September 11, 2009, only 3 business days prior to the filing of the Supplemental Amendment. Applicants' attorney's request for entry and consideration of the Supplemental Amendment or, alternatively, in removing the Finality of the current rejection were each denied.

Response to Restriction Requirement

The Office requires restriction of claims 12 and 13 as drawn to a method of making paper, asserting that the originally claimed invention, claims 1, 5, 8 and 9, are drawn to a composition. With the amendment to claim 12 to be dependent on claim 1, and to include the feature that the paper has a filler content above 20 wt% based on the total weight of the paper, claim 12 now shares in common the same or similar special technical features of independent claim 1.

The Office apparently asserts that independent claim 1 includes no special technical feature based on the disclosure of JP 2002-201202. Applicants respectfully traverse this restriction requirement. As discussed below, Applicants submit that independent claim 1 is patentable over JP 2002-201202 (in combination with Smook). Accordingly, reconsideration of the requirement for restriction is requested along with the rejoinder of claims 12 and 13 in the present application.

Amendments to the Claims

Applicants' claims 1 and 12 have been amended to recite that the paper has a filler content of above 20 wt% based on the total weight of the paper. Claim 12 has also been amended to be dependent on claim 1. Support for the amendments to claims 1 and 12, as well as new claims 14 and 15, can be found in the originally filed application, for example, at page 6, lines 10-12. No new matter has been added.

Response to Rejection Under 35 U.S.C. § 103(a)

Claims 1, 2, 5, 8 and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over JP 2002-201202 ("JP '202") in view of the Handbook for Pulp and Paper Technologies ("Smook"). Applicants respectfully submit that independent claim 1, as amended, is patentable over these cited references.

In its rejection, the Office acknowledges that JP '202 fails to disclose or suggest a paper comprising a filler or the solubility of the CMC. (Office Action, page 6). In regard to the feature of a filler, the Office attempts to combine JP '202 with Smook

alleging that Smook “is analogous as pertaining to additives used in paper” including “sizing agents, strength agents and fillers” (Office Action, page 6).

Contrary to the Office’s assertions, Applicants’ claims not only require a paper having a filler, but they also require a paper having a filler content of above 20 wt% based on the total weight of the paper. The Office concedes that JP ‘202 fails to disclose even the feature of a paper comprising a filler. Further, although Smook may disclose that a filler is one of many additives used in paper making, Applicants submit that Smook appears to be silent with regard to an amount of filler content for its paper, much less a paper having a filler content in the range claimed by Applicant. Thus, there appears to be no indication in Smook at all regarding the amount of filler content in paper. Nor is there any disclosure or suggestion in the combination of JP ‘202 or Smook of a paper having the specified filler content in combination with specified cellulose ether as recited in independent claim 1 (or as recited in the method of withdrawn independent claim 12).

In contrast to the alleged combination JP ‘202 and Smook, Applicants’ specification, for example at page 6, lines 10-12, discloses that the paper, as recited in claim 1, has an improved retention of the filler, thus having a filler content of above 20 wt% based on the total weight of the paper, which is higher than conventional papers. Consequently, as discussed at page 3, lines 6-7 of Applicants’ specification, the combination of the cellulose ether as recited in claim 1 and higher amount of filler content in the claimed paper product allows the highly filled paper to be produced more economically than conventional papers.

Thus, the combination of JP ‘202 and Smook fails to disclose or suggest each of the features recited in Applicants’ amended independent claim 1. Accordingly, the Office has not presented a *prima facie* case of obviousness. Pending claim 1 is therefore patentable over these cited references. Claims 2, 5, 8, 9, 12, 13-15 are also patentable for at least the reasons that claim 1, from which they respectively depend, are patentable, but may be separately patentable for additional reasons as well.

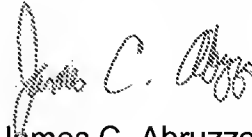
Response to Double Patenting Rejection

Claims 1-4, 6 and 7 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1-6, 8 and 15 of copending Application No. 11/149,613 in view of U.S. Patent No. 4,940,785 ("Stober"). Applicants' invention, however, as recited in amended independent claim 1 includes features that do not appear to be disclosed or suggested in claims 1-6, 8 and 15 of copending Application No. 11/149,613 in view of Stober. Accordingly, Applicants request reconsideration and withdrawal of the provisional double patenting rejection. Moreover, as the double patenting rejection is merely a provisional double patenting rejection, Applicants will postpone the filing of a terminal disclaimer, if necessary, until such time as all of the other remaining issues have been resolved.

Conclusion

In view of the amendments and arguments set forth above, Applicants respectfully submit that the pending application is in condition for allowance. Notice to this effect is earnestly solicited.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "James C. Abruzzo". The signature is fluid and cursive, with the first name "James" and last name "Abruzzo" clearly legible.

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